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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/419,752

10/16/1999

PETER AR-FU LAM

ESY2A

1738

7590
PETER AR-FU LAM
20104 WAYNE AVENUE
TORRANCE, CA 90503

04/18/2008

EXAMINER

ARMSTRONG, ANGELA A

ART UNIT

PAPER NUMBER

2626

MAIL DATE

DELIVERY MODE

04/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 09/419,752 | Applicant(s) LAM, PETER AR-FU | |
| | Examiner ANGELA A. ARMSTRONG | Art Unit 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/26/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 86-176 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 89-91, 129-134 and 176 is/are allowed.
- 6) ☒ Claim(s) 86-88, 92-128, 135-175 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 26, 2007 have been fully considered but they are not persuasive. Applicant argues the claimed invention recites statutory subject matter because the claims include limitations for computer devices and/or components. The Examiner argues the recited computer components are not encoded with the program so as to execute the instructions for having the computer perform the recited program steps so as to be realized as a product or process claim. Applicant argues the Office Action erred for failure to explain why the programming and communication tools and method are non-statutory. The Examiner argues the Specification defines (page 1, line 20) programming tool interfaces between the programmers and computers, clearly indicating the programming tool is a computer program or software. Additionally, at page 12, lines 1-40, the Specification describes the invention as a computer program. Additionally, claim 89, clearly recites the programming tool is a computer program. As such, review of the Specification and claims clearly indicate applicant's invention to a programming tool does not fall within either of the Office's statutory classes of invention. But instead recites the instructions executed by the computer and merely describes nonstatutory functional descriptive material. As such, the rejection under 35 USC 101 is maintained.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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3. Claims 86-88, 92-113, 114-119, 120-128, 135-147, 148-153, 154-169, and 170-175 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Regarding claims 86-88, the programming tool claims of 86-91 are directed to a computer program. Computer programs claimed as the description or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process (see USPTO Interim Guidelines for Patent Subject Matter Eligibility) and the Office treats a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program’s instructions, the Office treats the claim as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, the Office treats the claim as a product claim.

Regarding claims 92-113, 114-119, 120-128, 154-169 and 170-175, the programming method claims of 92-113, 114-119, 120-128, 154-169 and 170-175 are directed to a computer program. Computer programs claimed as the description or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and

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functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process (see USPTO Interim Guidelines for Patent Subject Matter Eligibility) and the Office treats a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, the Office treats the claim as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, the Office treats the claim as a product claim.

Regarding claims 135-147, the method claims of 135-147 to compose a compiler are directed to a computer program. Computer programs claimed as the description or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process (see USPTO Interim Guidelines for Patent Subject Matter Eligibility) and the Office treats a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, the Office treats the claim

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as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, the Office treats the claim as a product claim.

Regarding claims 148-153, the method of claims 148-153 to program a computer apparatus are directed to a computer program. Computer programs claimed as the description or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process (see USPTO Interim Guidelines for Patent Subject Matter Eligibility) and the Office treats a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program’s instructions, the Office treats the claim as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, the Office treats the claim as a product claim.

Allowable Subject Matter

5. Claims 89-91, 129-134, and 176 are allowed.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA A. ARMSTRONG whose telephone number is (571)272-7598. The examiner can normally be reached on Monday-Thursday 11:30-8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Angela A Armstrong/
Primary Examiner, Art Unit 2626